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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,385	10/17/2001	James T. Byers		7202

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James T. Byers  
25335 BUDDLE RD APT 611  
SPRING, TX 77380

EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/982,385

Applicant(s)

BYERS, JAMES T.

Examiner

Bradley Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 1-3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-3 are presented for examination on the merits.

#### ***Claim Objections***

**Claims 1-3 are objected to because of the following informalities:** the applicant at the end of each element repeatedly states that the element is dependent on the “system of claim 1.” Once the applicant shows the dependency in the preamble of the dependent claim, he need not repeat it at the ends of each element. It is understood that the whole dependent claim is dependent on the independent claim it recites in the preamble.

Also, the applicant repeats the same elements in the dependent claims without further limiting the claims, i.e., a public data network etc...

Claim 3 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim. An element of claim 3 recites a dependency on claim 2, but claim 3 depends on claim 1. The applicant cannot provide multiple dependencies in elements of dependent claims. See MPEP § 608.01(n).

The applicant should also separate different elements of each claim with a semicolon rather than a comma to avoid confusion as to what each element encompasses.

Furthermore, the applicant should be consistent in using the same preamble as recited in the independent claim without having to repeat the whole preamble or change the terminology in the preamble. For instance, for claim 2, the applicant may merely state: The system of claim 1, further comprising...” followed by the limitations.

Appropriate correction is required.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 1-3 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure, which goes to make up the system, must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Claim 1 recites the limitation "the necessary operating system" in line 4. There is insufficient antecedent basis for this limitation in the claim. Also, using vague language like "necessary" operating system renders the claimed subject matter indefinite.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Pare, Jr. et al., U.S. Patent 5,870,723.**

As per the following claim, Pare, Jr. et al. disclose:

1. A system for allowing pre-designated users at remotely located computer-based systems to perform electronic contract negotiations; comprising:

- a public data network (figure 1 and associated text);
- a computer with an Internet Web Browser and the necessary operating system, display device, and data input devices that are ordinary for the Web Browser; a computer software component for working in conjunction with the Internet Web Browser and for retrieving data from fingerprint scanning devices that are BioAPI Consortium compliant (column 4, line 40-column 10, line 40); and
- a Bio API Consortium compliant fingerprint-scanning device (column 12-13) .

2. A system for allowing remotely located users with a system of claim 1 to register as a signatory authority for electronic contract negotiations using a scanned and digitized human fingerprint to sign an electronic contract, comprising:

- a public data network (figure 1 and associated text);
- a computer or cluster of computers with Web Server software and the necessary operating system, display devices, and local storage for communicating with the system of claim 1 (figure 2 and associated text);
- a registration component for registering users for access to electronic contracts (column 22, lines 48-65);

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- a registration component for receiving binary fingerprint scan data from users with signatory authority for an electronic contract (column 23-24) ;

- a computer software component for working in conjunction with the Web Server software and designed for processing and analyzing binary fingerprint scan data received from the system of claim 1 (figure 12 and associated text);

- a computer software component for retrieving binary fingerprint scan data from the system of claim 1 (figure 11 and associated text);

- a computer database comprised of binary fingerprint scan data from all registered users with signatory authority (figure 2 and associated text);

- a computer software component for storing binary fingerprint scan data in a database for electronic signatures (column 53-54);

- a computer software component for generating a graphical visual representation of binary fingerprint scan data (column 49, lines 35-65); and

- a computer software component for generating Web pages for presenting visual representations of binary fingerprint scan data on the system of claim 1 (column 10, lines 57-65).

3. A system for allowing remotely located users with a system of claim 1 to sign an electronic contract using a scanned and digitized human fingerprint, comprising:

- a public data network (figure 1 and associated text);

- a system of claim 2 (see comments under 112 rejection);

- a fingerprint analysis component for extracting the necessary information of a set of binary fingerprint scan data to compare with other binary fingerprint scan data (column 7, lines 37-45);

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-a fingerprint comparison component for scanning a database of binary fingerprint scan data for a match (column 4, lines 43-49);

-a computer database comprised of electronic contracts, addendums, attachments, and revised contracts (column 26, line 45-column 27, line 59),

-a computer software component for storing binary fingerprint scan data as an electronic signature to an electronic contract (column 20-22);

-a computer software component for generating Web pages for presenting electronic contract information on the system of claim 1 (see columns 20-22);

-a system administration component for administering and configuring the databases and users (columns 41-42); and

-an audio and visual component that allows users to collaborate remotely for electronic contract negotiations (columns 43-44).

### ***Conclusion***

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale

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by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C.  
20402.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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